

**REMARKS**

Reconsideration of the present application and entry of the amendment are respectfully requested. Claims 27 to 53 are currently pending, and no claims have been amended.

The Office Action mailed April 16, 2003 addressed claims 27 to 53. Claims 46 to 53 were rejected, and claims 27 to 45 were withdrawn from consideration.

Claims 46 to 50, 52 and 53 were rejected under 35 U.S.C. 102(b) as being anticipated by Nesbitt (US 4,431,193). The Examiner stated that regarding claims 46, 47 and 50, Nesbitt discloses a golf ball comprising a core, an inner cover layer, and an outer cover layer. The Examiner stated that the inner cover layer is made from a hard, high flex modulus resin such as Surlyn 1605, which has a Shore D of 62, and the outer cover is made from a soft, low flexural modulus resin such as Surlyn 1855, which has a Shore D hardness of 55. The Examiner concluded that the spin factor is inherent since the materials are the same. Regarding claims 48 and 49, the Examiner stated that the inner cover layer thickness is from 0.020 to 0.070 inches and the outer cover layer thickness is from 0.020 to 0.100 inches. Regarding claim 52, the Examiner stated that the inner cover layer material has a flex modulus of 44,961, and regarding claim 53, the coefficient of restitution of the core is 0.770, and the COR of the core and inner cover layer is 0.800 or more. The Examiner concluded that Applicant's COR of 0.770 or more for the ball is inherent features of Nesbitt.

Applicants respectfully disagree with the Examiner. Nesbitt discloses a golf ball comprising a core and a multi-layer cover, and the inner cover layer comprises a hard, high flexural modulus ionomer, and the outer cover layer comprises a soft, low flexural modulus ionomer. Nesbitt uses as examples of suitable materials for use in the cover layers Surlyn® 1605 and 1855 ionomers, high and low flexural modulus ionomers respectively, but Nesbitt does not disclose or claim the specific Shore D of the inner cover layer or an outer cover having a Shore D hardness of no more than 55, nor does Nesbitt limit the cover to materials having a specific Shore D. Additionally, Nesbitt does not disclose or claim a spin factor at all.

Applicants respectfully submit that the burden is on the Examiner to provide a basis in fact and/or technical reason to reasonably support the determination that the allegedly inherent characteristics necessarily flow from the teachings of the prior art. Inherency must be a necessary

result and not merely a possible result. Applicants respectfully submit that the Examiner has failed to support the inherency determination with any facts or technical reasoning.

Since Nesbitt fails to teach each and every element of Applicants' claims, Applicants respectfully submit that Nesbitt does not anticipate Applicants' claims. Applicants respectfully submit that claims 46 to 50, 52 and 53 are not anticipated by Nesbitt and request that the rejection of claims 46 to 50, 52 and 53 under 35 U.S.C. § 102(b) be reconsidered and withdrawn.

Claim 51 was rejected under 35 U.S.C. 103(a) as being unpatentable over Nesbitt in view of Sullivan (US 5,098,105). The Examiner stated that Nesbitt discloses the invention as shown above but fails to disclose an ionomer for the outer layer with a flex modulus from 1,000 to 10,000 psi. The Examiner concluded that one skilled in the art would have modified the outer layer material to increase the durability of the golf ball.

Applicants respectfully submit that the Examiner has failed to make out a *prima facie* case of obviousness. As discussed above, Nesbitt discloses a golf ball comprising a core and a multi-layer cover, and the inner cover layer comprises a hard, high flexural modulus ionomer, and the outer cover layer comprises a soft, low flexural modulus ionomer, but Nesbitt does not disclose or claim the specific Shore D of the cover layers, nor does Nesbitt limit the cover layers to materials having a specific Shore D.

Sullivan discloses golf balls having a single cover layer formed from a blend of ionomers and maleic anhydride modified thermoplastic elastomers. Sullivan does not disclose a multi-layer cover, or more particularly, a multi-layer cover having an outer cover layer comprising an ionomer with a flex modulus of from 1,000 to 10,000 psi. Applicants respectfully disagree with the Examiner's statement that "Sullivan teaches an ionomer for a cover layer with a flex modulus from 2500 to 3500 psi." At column 9, line 47, Sullivan teaches an ionomer for use in a cover composition which comprises a blend of the particular ionomer (Iotek® 7520) with a hard ionomer, not the use of Iotek® 7520 alone as an outer cover layer of a multi-layer cover. Additionally Sullivan teaches the blend of ionomers for use in a single cover layer, not the outer cover layer of a multi-layer cover.

In the response to arguments the Examiner stated that "Sullivan clearly teaches the material used for the cover layer of the golf ball, which is equivalent to the outer cover layer of Nesbitt." Applicants respectfully disagree. As previously discussed, Sullivan discloses the use of

an ionomer blend, not the ionomer alone, as stated by the Examiner. Additionally, the use of this ionomer in the blend produces a cover with a Shore D hardness of 64 and 60 (see Table 11, where Iotek<sup>®</sup> 7520 is blended with Iotek<sup>®</sup> 4000 and Iotek<sup>®</sup> 8000). Therefore, even if there was motivation to use the ionomer of Sullivan, the Shore D of the cover layer would be greater than the Shore D of the outer cover layer of the present invention.

Applicants respectfully submit that there is no motivation to combine Nesbitt, which discloses and teaches golf balls having a specific type of multi-layer cover, with Sullivan, which teaches golf balls having a single layer cover formed from a blend of ionomer and maleic anhydride modified thermoplastic elastomers. One skilled in the art would not be motivated to make the golf ball of Nesbitt using the cover of Sullivan since the entire focus of Nesbitt is on a specific type of improved multi-layer ionomer cover for a golf ball. There is no motivation, teaching or suggestion to combine Sullivan with Nesbitt because Sullivan is directed to a particular type of cover made from a blend of ionomer and maleic anhydride modified thermoplastic elastomers, and the cover of Sullivan is a single layer cover with very different properties from the multi-layer cover of Nesbitt. Even if the cover of Sullivan was substituted for the cover of Nesbitt, a golf ball having a single layer cover comprising a blend of materials would be produced, not a golf ball having an outer cover layer comprising an ionomer with a flex modulus of 1,000 to 10,000 psi and a Shore D hardness of no more than 55.

For at least these reasons, Applicants respectfully submit that claim 51 is not obvious under 35 U.S.C. § 103(a) over Nesbitt in view of Sullivan. Applicants therefore respectfully request that the rejection of claim 51 under 35 U.S.C. § 103(a) as obvious over Nesbitt in view of Sullivan be reconsidered and withdrawn.

Claims 46 to 53 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1 to 42 of U.S. Patent No. 6,213,894. The Examiner stated that although the conflicting claims are not identical, they are not patentably distinct from each other because the present invention is anticipated by the '894 patent.

Although Applicants respectfully disagree, Applicants will file a terminal disclaimer once the other rejections have been overcome.

The Examiner is invited to telephone Applicants' attorney if it is deemed that a telephone conversation will hasten prosecution of the application.

**CONCLUSION**

Applicants respectfully request reconsideration and allowance of each of the presently rejected claims, claims 46 to 53. Applicants respectfully request allowance of claims 46 to 53, the claims currently pending.

Respectfully submitted,  
THOMAS J. KENNEDY, III et al.

Date: June 16, 2003  
Customer No. 24492  
Phone: (413) 322-2937

By Michelle Bugbee  
Michelle Bugbee, Reg. No. 42,370  
Attorney for Applicants  
The Top-Flite Golf Company  
425 Meadow Street  
P.O. Box 901  
Chicopee, MA 01021-0901

Cc: Richard M. Klein, Esquire (SLD 2 00218-3-1-3(I))